

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Tienteh CHEN et al.	§	Confirmation No.:	4418
		§		
Serial No.:	10/613,495	§	Group Art Unit:	1785
		§		
Filed:	07/02/2003	§	Examiner:	Bruce H. Hess
		§		
For:	Inkjet Recording	§	Docket No.:	200209928-1
	Materials	§		

REPLY BRIEF

Mail Stop Appeal Brief – Patents

Date: June 10, 2010

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated April 14, 2010, Appellants respectfully submit this Reply Brief for further consideration by the Board. Appellants provide the following additional comments to some, but not all, of their arguments from their principle brief. However, that Appellants have not provided additional comments to all arguments from the principle brief should not be construed as such arguments not being discussed herein as lacking merit. The Board is requested to consider all arguments made by Appellants in the principle brief and the additional arguments in this Reply Brief.

The Examiner contends that *the 131 Declaration's* statement of the prior art renders claims 1-4, 6 and 7 obvious. This conclusion fails to give proper weight to the art-recognized differences between photobased print media and paper based print media, which were known in the art and discussed in Dr. Chen's *Declaration under 37 CFR 1.132* filed on June 18, 2009 (Evidence Appendix B of the principal brief) (hereinafter, "*Dr. Chen's 132 Declaration.*") Among those differences are the lower quality images generally associated with paperbase media, cockling and wrinkling of paper base substrates, and the thick coat weights of the ink receiving layers required in photobased media for

high quality images. *Dr. Chen's 132 Declaration*, pp. 2-3 and 5, paragraphs 4-7 and 10-11.

The Examiner has not proffered any reasoned statement specifically disputing the statements in *Dr. Chen's 132 Declaration*, particularly paragraphs 4-7, 10 and 11. Instead, the Examiner concludes that, in view of the Appellants' statements in *the 131 Declaration*, "[c]onsequently, use of a known ink jet recording media base with a known ink jet recording layer would have been obvious to one of ordinary skill in this art in the absence of unexpected results."

Furthermore, the Examiner has not articulated any reason why one of skill in the art would have used an ink jet recording layer from a photobase media on a paperbase substrate, much less why there would have been a reasonable expectation of success in achieving a satisfactory print medium, sufficient to establish a *prima facie* case of obviousness. Appellants contend that in view of the prior photobase and paperbase art, the person of ordinary skill at the time of the invention would have been disinclined to try to combine those differing print media technologies, and would not have expected that a paperbase substrate with an ink receiving layer having the claimed composition and a coatweight in the 3-7 g/m² range would result in a satisfactory print media. To the contrary, the person of ordinary skill would have expected a print media with a paperbase substrate having the Sheffield values recited in claim 1 to cockle and wrinkle when employed with an ink receiving layer as per claim 1, which would render the product unsatisfactory.

Appellants contend that *Dr. Chen's 132 Declaration* is credible, persuasive evidence which counters any presumption of obviousness. The Examiner has not established a *prima facie* case of obviousness with respect to claims 1-4, 6 and 7, and the burden of rebuttal has not shifted to Appellants.

Based on the foregoing, Appellants respectfully submit that the Examiner erred in rejecting all pending claims. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such

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extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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